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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,326	02/20/2004	Michael J. Czaplicki	1001-133	6882

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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,326

Applicant(s)

CZAPLICKI ET AL.

Examiner

ROBERT SELLERS

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-13, 16-19 and 24-35 is/are pending in the application.
- 4a) Of the above claim(s) 35 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13, 16-19 and 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

This is responsive to the Request for continued Examination and amendment filed August 19, 2008. The limitation of the amount of epoxy component with a lower limit of about 50% by weight in independent claims 10, 24, 35 and 36 is set forth on page 2, line 25 of the specification.

1. The informal terminology in the specification raised in the Final rejection mailed September 12, 2006 on page 2, paragraphs 1-3 has been corrected by the amendment.
2. The amendment filed August 25, 2006 modifying page 2, lines 32-33 wherein the "epoxy resin may be a phenolic resin and/or a novolac [sic] type or other type resin" is unclear since a phenolic resin encompasses a novolac resin. If the "other type resin" is intended to be another kind of epoxy phenolic resin or epoxy novolac, it cannot be ascertained how that resin structurally and/or functionally differs from the phenolic or novolac is not disclosed. If the "other type resin" is meant to be another type of epoxy resin, it cannot be determined how that resin is structurally and/or functionally distinguished from the species listed in the following five lines.
3. Newly submitted claims 35 and 36 are directed to a species that is distinct from that originally claimed due to the additional presence of a filler which was not denoted in any of the original claims filed February 20, 2004. The further inclusion of a filler necessitates a burdensome additional search in class 523, subclass 457.

Since applicant has received an action on the merits for the originally presented species, this species has been constructively elected by original presentation for prosecution on the merits.

Accordingly, claims 35 and 36 are withdrawn from consideration as being directed to a non-elected species (37 CFR 1.142(b) and MPEP § 821.03).

The text of sections 102(b), 103(a) and 112 of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed May 25, 2006.

Claims 31, 33 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

4. The melt mixing of the epoxy component and elastomer in claims 31 and 34 is not substantiated. Pages 6-8 describing the preparation of the adduct merely discloses the mixing of the components in a batch process using a mixer such as an extruder (page 6, lines 6-10 and 15-19) without revealing the type of mixture (i.e. whether the components are combined by melt mixing or blending in the presence of a solvent).

5. The elastomeric component in claim 33 is not designated as "thermosetting" as described on page 3, line 18 of the specification and limited thereto in independent claims 10 and 24 to affirmatively denote its reactivity with the epoxy groups of the epoxy components since the species of elastomer listed on page 3, lines 24-32 do not contain any epoxy-reactive groups.

Claims 10-13, 16-19 and 24-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. It cannot be ascertained what maximum level of solvent is embraced by the word "substantial" used to characterize the absence of solvent in the solidification of the adduct in claims 10, 24 and 33 as well as the melt mixing of the components in claims 31, 32 and 34. The specification on page 13, line 18 describes "the adduct, when made without solvent" without confining the amount of solvent by the adjective "substantial."

7. The scope of the phrase "substantially entirely" quantifying the content of solid bisphenol A epoxy resin within the solid epoxy component in claim 33 is unclear since it cannot be determined what minimum proportion of solid bisphenol A epoxy resin is encompassed by the term "substantially." The specification on page 3, lines 5-6 describes an epoxy component "composed at least partially or substantially entirely of a relatively low average molecular weight epoxy resin without defining the parameters of the adverb "substantially."

Claims 10-13, 16-19, 24-26 and 28-34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over PCT Publication No. WO 95/33785 in view Lee and Neville's Handbook of Epoxy Resins, page 4-60; or Urech et al. Patent No. 4,908,273; Minamisawa et al. Patent No. 4,482,660; Golden Patent No. 6,586,089; McKown Patent No. 3,707,583 or Czaplicki et al. Patent No. 6,846,559.

Claims 19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to the claims hereinabove, and further in view of Japanese Patent No. 63-227686.

The rejections are maintained for the reasons of record set forth in the non-Final rejection and Final rejection mailed September 12, 2006. The arguments filed August 19, 2008 have been considered but are unpersuasive.

8. Neither the epoxy/elastomer adducts of the PCT publication (page 4, lines 28-29), Urech et al. (col. 6, Example 1), Minamisawa et al. (col. 6, Example 1, lines 23-26), Golden (col. 2, lines 31-33), McKown (col. 7, Example 1) nor Czaplicki et al. (col. 3, lines 23-37) are prepared in the presence of a curing agent which is added after its formation, thereby satisfying the newly claimed epoxy/elastomer being free of a curing agent.

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Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
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rs
11/20/2008